

REMARKS

In the Office Action dated September 5, 2006, a typographical error in claim 42 was noted, since claim 42 should depend from claim 27, as was correctly assumed by the Examiner, rather than from claim 21. Claim 42 accordingly has been corrected.

Claim 5 was rejected under 35 U.S. C. §101 as being directed to non-statutory subject matter, because the Examiner stated claim 5 does not produce a concrete and tangible result. The Examiner stated in claim 5, a threshold of the ink content in a reservoir is determined by counting the number of imprints, and the Examiner stated this does not produce repeatable results because the ink used during printing is directly proportional to the space covered by the ink on the printable medium, and claim 5 does not include resetting the threshold value before the start of a print job. This rejection is respectfully traversed for the following reasons.

Claim 5 describes a particular embodiment for the method step of claim 1 of electronically monitoring a consumption quantity associated with consumption of a supply item during the operation of a device, and repeatedly electronically comparing the consumption quantity to a threshold that represents consumption of the supply item. Therefore, it would destroy the intended operation of the method of claim 1 if a resetting of the count took place at the beginning of each print job. Claim 1 requires that a running total of the consumption be acquired for whatever consumable item is being monitored. Therefore, it is essential that this running total *not* be reset at the beginning of each print job. In order to monitor the total quantity of ink remaining in the reservoir, it is important that a running total be kept for *all* print jobs, so that when

the amount of ink remaining in the reservoir becomes dangerously low, i.e. below a particular threshold, re-ordering of a new ink reservoir is automatically triggered, in accordance with claim 1.

Claim 5, therefore, is not rendered as being non-statutory by not including such a resetting step. Claim 5 is therefore submitted to be in full compliance of all provisions of 35 U.S.C. §101.

Additionally, claims 1-7, 9, 10, 13-18 and 21-26 were rejected under 35 U.S.C. §103(a) as being unpatentable over Saito (Japanese Patent Application JP-02032665) in view of Barnes et al. Claims 27-40 and 42 were allowed.

Applicant notes with appreciation the interview courteously afforded the undersigned representative of the Applicant on November 15, 2006, wherein this rejection was discussed. As discussed at the interview, this rejection is respectfully traversed for the following reasons.

As stated at page 6 of the Office Action, the Examiner has acknowledged that the Saito reference does not teach the step of method claim 1 of filling an order only if a requested supply item conforms to the at least one permissible supply item. The Examiner relied on the Barnes et al reference as providing a teaching that enables purchasers and suppliers to electronically transact for the purchase and supply of goods or services. The Examiner stated the Barnes et al reference teaches the "idea" of storing data that represents a list of goods and services that are available for purchase by authorized user in a customer organization.

As discussed at the interview, Applicant agrees that the Barnes et al reference provides such a general "idea," but does so in a manner that is so completely different from the subject matter of independent claim 1 such that it would

be impossible for the system disclosed in the Barnes et al reference to operate in the manner set forth in claim 1. Therefore, not only is there no motivation, inducement, guidance or teaching to modify the Saito system in accordance with the Barnes et al reference in order to arrive at the subject matter of claim 1, but also, even if such a combination were made, it would not conform to the language of independent claim 1.

The Examiner is relying on the Barnes et al reference as providing teachings regarding an order-filling system wherein the items that can be supplied to a requesting entity (customer) are limited to items in a catalog list that is made available to the ordering entity. Dependent on the access level associated with a particular ordering entity, only a limited number of items from the entire catalog list are made available to the particular ordering entity. In substantiating these teachings of the Barnes et al reference, the Examiner cited statements from the Barnes et al reference from the introductory portion thereof. In view of their introductory nature, these statements are extremely general, and the actual details of the method and system disclosed in the Barnes et al are provided at subsequent passages in the Barnes et al reference. The basic steps for placing and filling an order in the context of the Barnes method and system are described at column 6, lines 33-65 of the Barnes et al reference. As can be seen from this more detailed explanation of how the Barnes et al method and system operate, the Barnes et al method and system differ in several significant respects from the subject matter disclosed and claimed in the present application.

First and foremost, there is no possibility discussed in the Barnes et al reference of a requested order not being filled, and therefore there is no need to

undertake a check at the order-filling location as to whether the ordering entity has requested an authorized item. This is because in the Barnes et al method and system, before a customer places an order, the customer is given the aforementioned catalog list, the contents of which may be restricted depending on the access level of the customer. The customer places an order only after already being provided with this (possibly limited) catalog list, but once the customer is presented with the customer list that is suitable for that customer, the customer is free to order any item on that catalog list. Therefore, a customer's order, since it can only be selected from the authorized list that is presented to the particular customer, can never include an item that is not on the presented list, and therefore there is no possibility for the customer to place an order that cannot be filled from the list. Thus, the Barnes et al method and system prevent the customer from ever generating an order that cannot be filled, because the customer is permitted to create the order only by selecting from a catalog list that is specifically designed so as *not* to include any items for which the particular customer in question is not authorized (by virtue of the customer's access level).

Moreover, the Barnes et al system defeats the possibility of being conducted completely automatically or completely electronically, because a manual selection by the customer must be made after the customer is presented with a list that is determined dependent on the customer's access level. Thus, it is necessary for a series of back-and-forth communications to take place between the customer and the order-filling facility. The customer must first identify himself or herself so that the customer's access level can be ascertained. Dependent on that access level, the customer is then presented, in a further communication, with an appropriate

customer list. The customer must then make a selection from that list and communicate that selection, in a further communication, to the order-filling facility.

In view of the fact that in the Barnes et al system a customer can *only* order from a pre-determined list, for which the customer has been approved with respect to the customer's access level, it is impossible in the Barnes et al system for the customer ever to place an order that cannot be filled. The customer in the Barnes et al system can *only* place an order from the approved list for which the customer has the appropriate access level, and therefore in the Barnes et al system can *never* place an order for an item that is not on that list, i.e., an item for which the customer is not an approved user. This being the case, there is no need whatsoever in the Barnes et al system for a check to be undertaken, at an order-filling location, as to whether the customer is requesting an approved item. Since the customer in the Barnes et al system can only place an order from the pre-approved list for that customer, it is *always* the case in the Barnes et al system that the customer will be requesting an approved item. A check in the Barnes et al system as to whether the customer is requesting a non-approved item would be completely superfluous.

The Examiner has acknowledged that the Saito reference does not teach filling an order only if the requested supply item conforms to at least one permissible supply item, but this is only a portion of the relevant language of claim 1. Claim 1 also requires that the order not be filled, if the search of the data bank of identification codes produces a negative outcome. Since making a check or search in the Barnes et al system as to whether an incoming order should be filled would be completely superfluous and therefore serve no purpose, there is no reason why a

person of ordinary skill would attempt to modify the Saito system in accordance with the teachings of Barnes et al in order to provide such a feature.

This feature is expressly set forth as the last element of claim 1, and is not disclosed or suggested in either the Saito or the Barnes et al references. Claim 1, therefore, would not have been obvious to a person of ordinary skill in designing re-ordering systems for a consumable item, under the provisions of 35 U.S.C. §103(a), based on the teachings of Saito and Barnes et al.

Claims 2-7, 9, 10, 13-18 and 21-26 add further steps to the non-obvious method of claim 1, and therefore none of those claims would have been obvious based on the teachings of Saito and Barnes et al, for the same reasons discussed above in connection with claim 1.

Claims 5, 11, 12, 14, 19 and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Saito and Barnes et al, further in view of a specification sheet for Canon Multipass C5500 (Canon). This rejection is traversed for the same reasons discussed above in connection with claim 1. Each of claims 5, 11, 12, 14, 19 and 20 embodies the subject matter of claim 1 therein, and therefore the above arguments with regard to the rejection of claim 1 based on Saito and Barnes et al are applicable to this rejection as well. Even if the Saito/Barnes et al combination were further modified in accordance with the teachings of the Canon reference, the subject matter of claims 5, 11, 12, 14, 19 and 20 still would not result, for the above-discussed reasons.

Claim 6 was rejected under 35 U.S.C. §103(a) as being unpatentable over Saito and Barnes et al and Canon, further in view of Froggger et al. This rejection is respectfully traversed for the same reasons discussed above in connection with

NOV 20 2006

claim 1. Even if the Saito/Barnes et al/Canon combination were further modified in view of the teachings of Frogger et al, the subject matter of claim 6, which embodies the subject matter of claim 1 therein, still would not result, for the above-discussed reasons.

Claims 27-40 and 42 were stated to be allowable. In view of the correction of the typographical error in claim 42, all claims of the application are submitted to be in condition for allowance.

The present Amendment merely corrects the aforementioned typographical error in claim 42, and therefore does not raise any new issues recurring further searching or consideration. Entry of the present Amendment after the final rejection is therefore proper, and the same is respectfully requested.

Submitted by,



(Reg. 28.982)

SCHIFF, HARDIN LLP
CUSTOMER NO. 26574

Patent Department
6600 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606
Telephone: 312/258-5790
Attorneys for Applicant.

CHI\4763224.1